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Magnus Nilsson

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Benton S. Duffett, Jr.
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

KALINOWSKI, ALEXANDER G

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAGNUS NILSSON

Appeal 2007-2376
Application 09/780,504
Technology Center 3600

Decided: February 25, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and DAVID B. WALKER,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 1-20.
35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

SUMMARY OF THE INVENTION

We REVERSE.¹

THE INVENTION

The invention is directed to a method and system for automated book-keeping. A server is provided with a banking service application and an account service application, the latter being connected to a bookkeeping database. Specification 1:30-35. Data for transactions related to a client's bank account are entered in the banking service application, part of which is used as accounting information in the account service application for updating the bookkeeping database. (Spec. 2:3-7). "With the inventive method, a vast reduction of the accounting workload is possible, since the data that is entered to the banking service application, is at least to a part reused for accounting." (Spec. 2: 15-18).

Claims 1-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Boublik (U.S. Patent Application No. 2001/0027420).

The rejection of claim 1 under 35 U.S.C. 102(e) over Boublik.

Claim 1 reads as follows:

1. A method for at least partly automated bookkeeping, comprising:
providing a server with a banking service application and an account service application, said server being accessible to at least one client through

¹ Our decision will make reference to Appellants' Appeal Brief ("Appeal Br.," filed Nov. 11, 2005), the Examiner's Answer ("Ans.," mailed Jun. 19, 2006), and to the Reply Brief ("Reply Br.," filed Aug. 15, 2006).

a wide area network, wherein said account service application is connected to a bookkeeping database,
receiving, at said server, data representing instructions for at least one transaction,
using said data in the banking service application for conducting the transaction,
using at least part of said data as accounting information in the account service application for updating said bookkeeping database.

A. Issue

The Appellant contends that Boublik does not disclose the banking service application set forth in claim 1 and thus does not teach every limitation of the claim.

The Examiner contends that “Figure 9 of Boublik discloses a “Banking Partner”” (Ans. 6) and that at least paragraph 0032 of Boublik discloses “a server that includes applications to 1.) collect relevant online procurement transaction information and 2.) converts the information to an accounting package” (Ans. 6). According to the Examiner, once the claim term “banking service application” is given the broadest reasonable construction

“Boublik’s application for collecting relevant online procurement transaction information is analogous to Appellant’s banking service application because Boublik’s application at least exchanges money and facilitates the transmission of funds via the “Banking Partners” of Figure 9. As required by the claim 1, Boublik then takes the transaction information via the account service application for updating the book-keeping database (see at least paragraphs 0032, 0058 and 0060).

Ans. 6-7.

The issue is whether the Appellant has shown that the Examiner erred in rejecting the claims as anticipated by Boublik.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Boublik is directed to “a method and/or system for automating portions of the tasks typically required for business transactions using a computer system.” Para. [0001]. Boublik seeks to remove the steps of data re-entry for small businesses when conducting transactions online. Para. [0005] This is accomplished by importing information associated with an online purchase transaction into a purchaser’s accounting package. Paras. [0050] and [0060].
2. The Examiner found that Boublik discloses a server “with a banking service application (see ¶ 0052)” (Ans. 3) and discloses “using data in the banking service application for conducting the transaction, using at least part of said data as accounting information in the account service application for updating said bookkeeping database (see ¶ 0058)” (Ans. 3-4). The Examiner also relied upon paras. [0032] and [0060] to show that Boublik discloses using banking service application data via the account service application for updating the book-keeping database. (Ans. 7).
3. There is no mention of a banking service application or the use of banking service application data in Boublik paras. [0052], [0058], [0032], and [0060].
4. “Banking Partners” is included in Boublik Figure 9 as part of an illustration of an example of a “high level architecture according to an embodiment of the

invention” Para. [0022] (See discussion at Ans. 6). Boublik mentions that the invention allows users to have transaction data from an online procurement site automatically entered into a user’s financial application. Para. [0007]. (See discussion at Ans. 3).

5. The Examiner found that Boublik shows a server being accessible to at least one client through a wide area network, an account service application connected to a bookkeeping database, server data representing instructions for at least one transaction, and using at least part of the data as accounting information in the account service application for updating the bookkeeping database. (Ans. 3-4). Appellant did not dispute these findings.

6. Appellant argued that Boublik fails to show a banking service application. (App. Br. 3-6 and Reply Br. 1-3).

C. Principles of Law

1. Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

2. It is well settled that in order for the examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431; *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v.*

American Hoist and Derrick, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

3. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

4. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

5. "If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

D. Analysis

We will not sustain the rejection. The rejection is under 35 U.S.C. § 102 and thus the claims are rejected on the ground that Boublik anticipates the claimed

subject matter. Accordingly, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.

We agree with the Examiner's analysis that Boublik shows a server being accessible to at least one client through a wide area network, an account service application connected to a bookkeeping database, server data representing instructions for at least one transaction, and using at least part of the data as accounting information in the account service application for updating the bookkeeping database. (FF 5).

However, we agree with Appellant that the Examiner has not shown that Boublik explicitly describes a banking service application as recited in claim 1. (FF 2 and 3). (A banking service application is also recited in the other independent apparatus claim 9.)

Since there is no explicit teaching of this claimed limitation in Boublik, the only question is whether Boublik describes a banking service application under principles of inherency. Under that theory, anticipation of the subject matter will have been established if the Examiner shows it *necessarily follows* from the teachings of Boublik, and thus is inherent to the Boublik method/system. We find that the Examiner's has not satisfactorily shown that a banking service application is inherent to the Boublik method/system.

We observe that the Examiner responded to Appellant's arguments in the Brief by arguing, in effect, that Boublik is *capable* of including a banking service application. The Examiner pointed out that Boublik discloses the term "Banking Partners" at Fig. 9 of Boublik. (FF 4). The Examiner argued that "Boublik's

transaction processing system uses Banking Partner's (see Figure 9) to collect transaction data which is then updated in a book-keeping database." (Ans. 7). However, Boublik nowhere explains the purpose of the "Banking Partner" depicted on Figure 9 that a "Banking Partner" collects transaction data to update a bookkeeping database is speculation and does not *necessarily follow* from, and thus is not inherent to, the method/system Boublik describes. The Examiner also pointed out that Boublik mentions that the invention allows users to have transaction data from an online procurement site automatically entered into a user's financial application. (FF 4). Be that as it may, the claim requires data from the banking service application to be used in the account service application. Using data from a banking service application to be used in the account service application does not *necessarily follow* from, and thus is not inherent to, the method/system Boublik whereby online data is automatically entered into a financial application. Finally, the Examiner argued that the claim term "banking service application" is broad in scope, encompassing Boublik's "online procurement transaction information" (Ans. 6). However, not every "online procurement transaction information" involves banking. Therefore, a banking service application does not *necessarily follow* from, and thus is not inherent to, Boublik's "online procurement transaction information".

The Examiner's apparent reasoning that the Boublik method/system is *capable* of including a banking service application appears to be rational. But the question before us is not one of obviousness but one of anticipation. Under the theory of inherency, inherency may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

E. Conclusion of Law

On the record before us, Appellant has shown that the Examiner erred in rejecting the claims over Boublik.

DECISION

The decision of the Examiner rejecting claims 1-20 under 35 U.S.C. § 102(e) as being unpatentable over Boublik is reversed.

REVERSED

JRG

Benton S. Duffett, Jr.
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404